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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/856,322	08/20/2001	Punit Satyavart Ramrakha	2292/OJO86	6859

7590

11/04/2002

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EXAMINER

LI, QIAN J

ART UNIT	PAPER NUMBER
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1632

DATE MAILED: 11/04/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/856,322

Applicant(s)

RAMRAKHA ET AL.

Examiner

Q. Janice Li

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 17-32 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

The preliminary amendment has been entered. The applicant requests to cancel claims 1-19, but only 16 claims were originally presented. New claims 20-35 have been renumbered as claims 17-32 according to 37 C.F.R. § 1.126.

Election/Restrictions

1. This application contains the following inventions or groups of inventions, which are not so linked as to form a single inventive concept under PCT Rule 13.1. Restriction is required under 35 U.S.C. 121 and 372.

Group I. Claims 17, 27, and 28, drawn to a biological tissue comprising endothelial cells which may be induced to generate a compound which down-regulates the expression of a cell adhesion molecule, wherein the compound is a polynucleotide complementary in sequence to part of the adhesion molecule gene.

Group II. Claims 17, 27, and 28, drawn to a biological tissue comprising endothelial cells which may be induced to generate a compound which down-regulates the expression of a cell adhesion molecule, wherein the compound is a mRNA that encodes the cell adhesion molecule.

Group III. Claims 17, 27, and 28, drawn to a biological tissue comprising endothelial cells which may be induced to generate a compound which down-regulates the

expression of a cell adhesion molecule, wherein the compound is a polynucleotide comprising a ribozyme sequence that specifically target a gene or mRNA.

Group IV. Claims 17, 18, 27, 28, and 31, drawn to a biological tissue comprising endothelial cells which may be induced to generate a compound which down-regulates the expression of a cell adhesion molecule, wherein the compound is a polypeptide with specific binding affinity for the cell adhesion; and a method of expressing the polypeptide.

Group V. Claims 19-24, drawn to a polypeptide comprising a binding region and a signaling region.

Group VI. Claims 25-26, drawn to a polynucleotide and a vector comprising the polynucleotide.

Group VII. Claims 29 and 30, drawn to a non-human animal comprising a biological tissue comprising endothelial cells which may be induced to generate a compound which down-regulates the expression of a cell adhesion molecule, wherein the compound is a polynucleotide complementary in sequence to part of the adhesion molecule gene.

Group VIII. Claims 29 and 30, drawn to a non-human animal comprising a biological tissue comprising endothelial cells which may be induced to generate a compound which down-regulates the expression of a cell adhesion molecule, wherein the compound is a mRNA that encodes the cell adhesion molecule.

Group IX. Claims 29 and 30, drawn to a non-human animal comprising a biological tissue comprising endothelial cells which may be induced to generate a compound which down-regulates the expression of a cell adhesion molecule, wherein the compound is a polynucleotide comprising a ribozyme sequence that specifically target a gene or mRNA.

Group X. Claims 29 and 30, drawn to a non-human animal comprising a biological tissue comprising endothelial cells which may be induced to generate a compound which down-regulates the expression of a cell adhesion molecule, wherein the compound is a polypeptide with specific binding affinity for the cell adhesion

Group XI. Claim 32, drawn to a method of transplantation in an animal.

2. The invention listed as groups I-XI do not relate to a single inventive concept under PCT Rule 13.1, because under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Groups II-X differ from group I in that they are different products (different tissue cells that expressing different compounds, polynucleotides, polypeptides, and non-human animals with different phenotypes). 37 CFR 1.475 (b) states "AN INTERNATIONAL OR A NATIONAL STAGE APPLICATION CONTAINING CLAIMS TO DIFFERENT CATEGORIES OF INVENTION WILL BE CONSIDERED TO HAVE UNITY OF INVENTION IF THE CLAIMS ARE DRAWN **ONLY TO ONE** OF THE FOLLOWING COMBINATIONS OF CATEGORIES: (1) A PRODUCT AND A PROCESS SPECIALLY ADAPTED FOR THE MANUFACTURE OF SAID PRODUCT; OR (2) A PRODUCT AND A PROCESS OF USE OF SAID PRODUCT; OR (3) A PRODUCT, A PROCESS SPECIALLY ADAPTED FOR THE MANUFACTURE OF THE SAID PRODUCT,

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AND A USE OF THE SAID PRODUCT; OR (4) A PROCESS AND AN APPARATUS OR MEANS SPECIFICALLY DESIGNED FOR CARRYING OUT THE SAID PROCESS; OR (5) A PRODUCT, A PROCESS SPECIALLY ADAPTED FOR THE MANUFACTURE OF THE SAID PRODUCT, AND AN APPARATUS OR MEANS SPECIFICALLY DESIGNED FOR CARRYING OUT THE SAID PROCESS." Since multiple products are claimed, unity of invention is lacking and restriction is required.

Group IV and XI are drawn to the combination of category (3), however, as cited in the International Preliminary Examination Report, Group IV, not group XI is anticipated over the cited prior art of record (Elices et al and Robinson et al), therefore, the special technical feature which links claims of group IV and XI does not provide a contribution over the prior art as a whole, so unity of invention is lacking.

3. In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is advised that where a single claim encompasses more than one invention as defined above, upon election of an invention for examination, said claim will only be examined to the extent that it reads upon the elected invention.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim

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remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Q. Janice Li whose telephone number is 703-308-7942. The examiner can normally be reached on 8:30 am - 5 p.m., Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah J. Reynolds can be reached on 703-305-4051. The fax numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of formal matters can be directed to the patent analyst, Dianiece Jacobs, whose telephone number is (703) 305-3388.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235. The faxing of such papers must conform to the notice published in the Official Gazette 1096 OG 30 (November 15, 1989).

Q. Janice Li
Examiner
Art Unit 1632

QJL
October 31, 2002

ANNE M. WEHBE' PH.D
PRIMARY EXAMINER

